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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,593	06/17/2005	Akihiko Shirakawa	Q73676	4782
23373 7590 01/27/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER HOBAN, MATTHEWE				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,593

Applicant(s)

SHIRAKAWA ET AL.

Examiner

Matthew E. Hoban

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 9-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/2008 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process*

Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "single crystal" in claim 1 is not used in its normal sense. A single crystal cannot be made up of a multitude of particles, as its definition is that it must be of a continuous lattice structure with no grain boundaries or second phases. The claims is to a single crystal made up of a collection of particles. Particles inherently have grain boundaries and thus a collection of particles cannot in and of itself a single crystal. The term is indefinite because the specification does not clearly redefine the term. A proposed amendment would be to change the claim to "A barium titanate, in the form of single crystal particles".

Previous Rejection

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(a) as being anticipated by S. Wada et al (S. Wada "Preparation of nm-ordered Barium Titanate Fine Particles using the 2-step Thermal Decomposition of Barium Titanyl Oxalate and Their Dielectric Properties", Proceedings of the IEEE International Symposium on Applications of Ferroelectrics, 13th, Nara, Japan, May 28-June 1, 2002 (2002), 263-266).

The disclosure of Wada teaches the creation of nm-size barium titanate particles that are defect and impurity free (See abstract and pg. 265 column 2). Overall Wada's invention is a thermally decomposed Barium titanyl oxalate that goes through a modified two step process. Upon completion of this process it was found that the product was single crystal, defect and impurity free, which reads directly on claims 1-3 of the instant application. The exact percentage of defect free particles is not directly recited, however the language of the author leads one to reasonably believe that nearly all of the particles are free of defects (Relevant to claims 1-3). Furthermore, Wada does not recognize his particles as having voids of the large size stated in the claims. Therefore, by his disclose 100% of these particles are free of such large voids. The particles of Wada were stated as having a size of 16.5 nm, as verified through TEM observation, by simply calculating under the assumption that the particles were perfect spheres this leads to a specific surface area of $62.9 \text{ m}^2/\text{g}$. Other factors in this calculate were density, which was recited as being 5.89 g/cm^3 by Wada. The assumption of the particles being perfect spheres is a sound one, even if the particles were elliptical with a high aspect ratio, their specific surface area would still be much greater than the value of $0.1 \text{ m}^2/\text{g}$ as recited by the instant claims (Relevant to claim 4). The final product of Wada's research did not incorporate any dopants or additional elements as recited in claim 6. Finally the products attained by Wada were in the form of powders (See Experimental Section, Paragraph 1) (relevant to claim 7). The major difference between the two processes is the fact that Wada uses a solid state thermal decomposition process, where the applicant uses a wet process; however, the process by which these powders were obtained gives no grounds for patentability, since the final products appear to be exactly the same. Both products are free of internal hydroxyl groups, which cause defects and voids of over 1 nm, and both have relatively high specific surface area, due to their small size (relevant to claim 8).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Wada et al (S. Wada "Preparation of nm-ordered Barium Titanate Fine Particles using the 2-step Thermal Decomposition of Barium Titanyl Oxalate and Their Dielectric Properties", Proceedings of the IEEE International Symposium on Applications of Ferroelectrics, 13th, Nara, Japan, May 28-June 1, 2002 (2002), 263-266) in view of Venigalla et al (US Application Number 10/244828, thus forth referred to as '828).

In reference to the disclosure of the instant application, detection of an abrupt peak at around 3500 cm⁻¹ by infrared spectrum analysis refers to the presence of hydroxyl groups in the sample

Wada et al teaches a barium titanate, which is **single crystal** in the form of particles, where the sample is **defect-free and impurity-free** (no voids greater than 1nm in diameter). The paper states that there are no internal hydroxyl groups; however hydroxyls are adsorbed on the surface of the particles (see page 265, column 2). These results were obtained through infrared spectroscopy and thermogravimetric analysis.

The difference between these two products is the fact that the one of the instant claim apparently contains no adsorbed hydroxyl groups, while the product of Wada et al does.

However, the removal of adsorbed hydroxyls is an aspect taught by '828 in the following passage:

"[0020] One method involves heating the barium titanate-based particles to remove hydroxyl groups (i.e., OH.sup.-groups) from particle surfaces. The hydroxyl groups may be ionic species, or may be part of a compound (e.g., H.sub.2O). The hydroxyl groups may be chemically, physically, or otherwise attached or associated with the particle surfaces. In particular, barium titanate-based particles that are produced using a hydrothermal process and conventionally dried generally have hydroxyl groups attached to their surfaces. Thus, such barium titanate-based particles are particularly well-suited to be treated using this heating method. In some cases, hydroxyl groups resulting from hydrothermal processing comprise between about 1% and about 2% of the total weight of the particulate composition. It is to be understood, however, that barium titanate-based particles produced using other processes may also have hydroxyl groups attached to their surfaces and can be treated using the heating method.

[0021] The hydroxyl groups are removed by heating the particles to a sufficient temperature and for a sufficient time so as to cause the hydroxyl groups to detach from particles surfaces. The specific heating conditions may depend upon characteristics of the particulate composition including composition size and particle size amongst others. Conventional drying temperatures (e.g., 200.degree. C. or less) have been found to be too low to sufficiently remove hydroxyl groups from particle surfaces. The heating step is generally carried out at temperatures and times that are insufficient to cause substantial particle growth and insufficient to cause particle sintering. In one set of embodiments, the particles are heated to a maximum temperature of greater than about 300.degree. C. and less than about 500.degree. C. to remove the hydroxyl groups. In some embodiments, the maximum temperature is between about 350.degree. C. and about 450.degree. C. (e.g., about 400.degree. C.). It may be desirable to maintain the particulate composition at a

relatively constant temperature between about 300.degree. C. and about 500.degree. C. for a dwell period. Though in other cases, the particulate composition is heated to the maximum temperature within this range but then cooled without the dwell period.

[0022] Heating time generally depends on the size of the particulate composition and can be readily determined by one of ordinary skill in the art. Any suitable heating system (e.g., furnace, vacuum furnace) can be used to heat the particles. After heating the particles are cooled, generally to room temperature."

Thus, It would have been obvious to one of ordinary skill in the art to remove hydroxyls at the time the invention was filed when Wada is modified in view of US '828 because US '828 teaches the use of the above heating process is said to remove adsorbed hydroxyl groups from barium titanate. Although this process is specifically designed for use with particles obtained through hydrothermal synthesis, the inventor states that barium titanate obtained through other processes can be heat-treated and refined using the above process.

The particles created by Wada only had hydroxyl's adsorbed to the surface, and had no internal lattice hydroxyls. Normally, the removal of hydroxyls would cause defects in the particles; however, these defects are associated with the removal of hydroxyls from the internal cavities of the particles and are not associated with the removal of adsorbed hydroxyls. Since only adsorbed hydroxyls would be removed from Wada's particles, since there were no internal hydroxyls, no defects would arise from the heat treatment proposed by '828. Finally after this heat treatment there would be no hydroxyls

adsorbed on the surface of the particles or in the lattice of the barium titanate, meaning that there could be no hydroxyls in or on the particles leading to the absence of an IR peak at 3500 cm^{-1} .

There is significant motivation to combine these two inventions because a particle of barium titanate with less surface impurities leads to a sintered final product with better, more consistent properties. It is well known in the art that hydroxyls, on the surface or internal, decrease the capacitance of any barium titanate capacitor.

Response to Arguments

1. Applicant's arguments filed 11/17/2008 have been fully considered but they are not persuasive. However, it is clear now that the submitted Japanese document to Wada does show a similar production means and is applicable to the NPL also authored by Wada. Nevertheless, the Japanese patent document still does not prove the point that the applicant's are trying to make. The Japanese document speaks of removal of water around the 100C regime of DTA, where another loss is seen between 400-600C. Reflecting upon both documents as far as this issue is concerned, one sees that the NPL document states the carbonate and hydroxyl groups are adsorbed on the surface of the particles as well as water. As applicant stated in arguments, the loss of mass between 400 and 600C is due to the loss of hydroxyl groups. In light of the NPL document, it is quite clear that this loss is due to surface hydroxyl groups rather than

hydroxyls within the lattice. Therefore, the presupposition that this 2-3% loss proves there are defects in the crystalline lattice is unconvincing.

2. Applicant goes on to argue based on the density of the particles and how the density relates to defects. However, applicant has not shown that particles of such size and density have the voids claimed. It is agreed that the inherent error of the measurement means is moot and the difference in density should be seen as .11 g/cc.

Finally, the examiner relies on the TEM for support of the statement that the particles are impurity and defect free. This statement is made explicitly worded in the abstract of the article at line 4. The arguments against the article of Wada pertaining to the veracity of Wada based on selectively choosing a defect free single crystal are wholly unconvincing. One cannot presuppose that the author of a peer-reviewed and published article skewed their research to provide such results. Furthermore, this image is only used in support of Wada's own explicit statement of a defect and impurity free crystal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Hoban whose telephone number is (571) 270-3585. The examiner can normally be reached on Monday - Friday from 7:30 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/
Supervisory Patent Examiner, Art Unit 1793

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